

**PATENT**

Atty Docket No.: 200300594-1

App. Ser. No.: 10/666,577

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. Claims 2-3, 5, 22, 36-39, and 42 have been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 1, 4, 6-21, 23-35, 40, 41, and 43-45 remain pending, of which claims 1, 20 and 40 are independent.

Claims 20, 21, 23-30, 34, 35 and 40-45 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaler et al. (6,766,334).

Claims 31 and 32 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaler et al. in view of Devarakonda et al. (2004/0111422).

Claim 33 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaler et al. and Devarakonda et al. in view of Szabo (7,181,438).

The above rejections are respectfully traversed for at least the following reasons.

**Restriction Requirement**

In an Office Action dated June 27, 2007, the Examiner issued a restriction requirement alleging that the application contains two groups of inventions: Group I directed to claims 1, 4, and 6-19 and Group II directed to claims 20, 21, 23-35, 40-41, and 43-45.

In response to the aforementioned restriction requirement, an election was filed on July 27, 2007 to elect *with traverse* Group II for examination. The election also included arguments that the restriction requirement was improper.

MPEP 821.01 states,

Where the initial [restriction] requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it

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should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

It is respectfully submitted that in the outstanding Office Action dated August 10, 2007, the Examiner did not respond to arguments advanced against the restriction requirement to indicate whether such a requirement is improper. Indeed, the Examiner did not address the arguments against the restriction requirement, as provided along with the election *with traverse*, at all.

Accordingly, it is respectfully submitted that the restriction requirement dated June 27, 2007 was improper for at least the reasons set forth in the election filed on July 27, 2007. Furthermore, it is respectfully submitted that the outstanding Office Action dated August 10, 2007 was also improper because it failed to address the arguments against the restriction requirement as provided in the filed election. Withdrawal of the restriction requirement and examination of claims 1, 4, and 6-9 of the alleged Group I are therefore respectfully requested.

**Claim Rejection Under 35 U.S.C. §103**

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be

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patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issues, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

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Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 20, 21, 23-35, and 40-45 were rejected under U.S.C. §103(a) as allegedly being unpatentable over Kaler et al. in view of an Official Notice and one or more other references (Devarakonda et al. and Szabo).

**Independent Claim 20 (and its dependent claims 21 and 23-35)**

Claim 20 recites, *inter alia*, "performing an action in response to the predetermined condition existing, wherein the relation identifier identifies the predetermined condition and the action."

In the outstanding Office Action, the Examiner alleged,

Official Notice is taken that incorporating the action into the relation identifier is well-known and expected in the art. It would have been obvious to one of ordinary skill in the art to incorporate the action into the relation identifier for the purpose of automating the incorporation of a user change into the project file [col. 10, lines 25-40].

MPEP 2144.03(B) specifically states,

***If Official Notice is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line of Reasoning Underlying a Decision to Take Such Notice Must Be Clear and Unmistakable.***

MPEP 2144.03(B) further states that "[t]he examiner must provide *specific factual findings* predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." (Emphasis added). Indeed, as noted above, the Supreme Court has held in *KSR International Co. v. Teleflex Inc.* that "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some

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articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

It is respectfully submitted that the Examiner statement of "Official Notice is taken that incorporating the action into the relation identifier is well-known and expected in the art" is merely a conclusion of common knowledge of the Examiner's decision to take such Office Notice. Thus, the Examiner failed to provide any technical line of reasoning underlying such decision or any specific factual findings predicated on sound technical and scientific reasonings to support the Examiner's conclusion of common knowledge. In other words, mere allegation without factual findings is not sufficient for a proper Official Notice.

The Examiner also alleged that an action can be incorporated into a relation identifier as claimed "for the purpose of automating the incorporation of a user change into the project file" in Kaler et al. In other words, the Examiner alleged that such incorporation of an action into a relation identifier is a known technique to improve a similar or known device to yield predictable results. However, the alleged predictable result is the automation that already exists in Kaler et al., without any further need for incorporating an action into a relation identifier as the Examiner alleged. Therefore, one of ordinary skill in the art would not have found it obvious, common knowledge, or well-known in the art to incorporate an action into a relation identifier when no improvement would have been made to the disclosure in Kaler et al. at all.

MPEP 2144(C) also states,

***If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner must Support the Finding with Adequate Evidence***

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It is respectfully submitted that the above challenge adequately traverses the alleged finding of Official Notice by specifically pointing out the errors in the Examiner's action and stating why the noticed fact is not considered to be common knowledge or well-known in the art. Thus, the Examiner must support such Official Notice with adequate evidence as stated in the MPEP.

Because the references cited by the Examiner failed to teach or suggest all claimed limitations, the Examiner failed to establish a prima facie case of obviousness against claim 20, it is respectfully submitted that claim 20 and its dependent claims 21 and 23-35 are allowable over the references of record, and withdrawal of the rejection of these claims is respectfully requested.

Independent Claim 40

Claim 40 recites, *inter alia*, "event means for determining whether a file of the plurality of files is accessed, identifying a predetermined condition associated with the file, and performing an action in response to the predetermined condition existing."

In the outstanding Office Action, the Examiner alleged that in Kaler et al., an action is performed when the version 2 file is modified in response to an identification of the version 2 file, which the Examiner alleged as the predetermined condition existing that is associated with the version 2 file, as claimed.

It is respectfully submitted the Examiner did not resolve the factual inquiries as required by *Graham v. John Deere Co. of Kansas City* noted above. Namely, the Examiner failed to properly ascertain the differences between the prior art and the claims at issue because an identification of a file, as shown in Kaler et al., is not the same as an identification of an

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existing condition of the file, as claimed. By analogy, one cannot equate identifying a person to identifying *a condition* of such person. Accordingly, Kaler et al. failed to show those claimed elements as alleged, and the Examiner failed to establish a *prima facie* case of obviousness against claim 40.

Because the references cited by the Examiner failed to teach or suggest all claimed limitations, the Examiner failed to establish a *prima facie* case of obviousness against claim 40. Accordingly, it is respectfully submitted that claim 40 and its dependent claims 41 and 43-45 are allowable over the references of record, and withdrawal of the rejection of these claims is respectfully requested.

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**Conclusion**

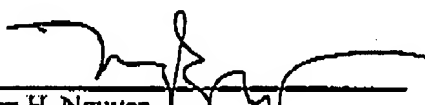
In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: November 13, 2007

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